IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:	VON DEYN ET AL.	CONFIRMATION NO.:	4685
SERIAL NO.	09/748,006	GROUP ART UNIT:	1626
FILED:	DECEMBER 27, 2000	EXAMINER:	ROBERT GERSTL

FOR: 3-HETEROCYCLYL-SUBSTITUTED BENZOYL DERIVATIVES

12/23/02

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

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Signature

November 05, 2002
Date of Signature

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

REPLY UNDER 37 C.F.R. §1.111

Sir:

In reply to the Office action of June 05, 2002, it is respectfully requested that the following remarks be entered and considered for further prosecution of the above-identified application:

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REMARKS

Claims 1 to 23 as submitted in applicants' preliminary amendment remain pending in this case.

The Examiner has required election of, and restriction of the application to, one of the following groups of claims:

I. Claims 1 to 16 and 21 to 23, drawn to compounds (I) classified in class 548, subclass 271;

II. Claim 17, drawn to a process of making the compounds classified in class 548, subclass 217; and

III. Claims 18 to 20, drawn to intermediate compounds (III) classified in class 548, subclass 183,

contending that the respective groups relate to independent and distinct inventions. Applicants herewith elect Group I, ie. Claims 1 to 16 and 21 to 23. Traversal of the Examiner's restriction requirement is however respectfully solicited in light of the following.

With regard to the requirement to restrict between the claims of Group I and II, the Examiner argues that the restriction requirement is supported by the guidelines in MPEP §806.05(f) because applicants' compounds of Group I can be made by other methods than the process of Group II. MPEP §806.05(f) provides that a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown:

(A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or

(B) that the product as claimed can be made by *another and materially different* process.

(*emphasis added*). Accordingly, it is not sufficient for a showing of distinctness that the product as claimed can be made by more than one process. It must also be shown that the other process which is suitable to make the product as claimed is materially different.

Furthermore, MPEP §803 provides that two criteria have to be met for a requirement to restrict between patentably distinct inventions to be proper:

(A) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); and

(B) There must be a serious burden on the examiner unless restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02).

As addressed in the foregoing, the Examiner has not met the burden to show that applicants' product can be made by a different process which is also *materially different* from the process as claimed. Accordingly, the first of the two criteria for a proper restriction requirement has not been met. Additionally, any disclosure which relates to a process which provides applicants' products as claimed

necessarily also relates to applicants' compounds (I). Accordingly, a reference which is pertinent with regard to the products as claimed is also pertinent with regard to process(es) suitable to prepare the product and *vice versa*. The inclusion of the process claim in one application together with the claims drawn to the product, therefore, cannot be considered to pose an additional or undue burden on the Examiner, and the second of the two criteria for a proper restriction requirement is also not met. Favorable reconsideration of the Examiner's position and withdrawal of the respective restriction requirement is solicited.

With regard to the requirement to restrict between Groups I and III, the Examiner argues that the restriction requirement is supported by the guidelines in MPEP §806.04(b) because *"the intermediate is deemed useful as product"*. However, the mere classification of a compound as a *"product"* does not render the compound useful per se, and cannot be deemed to meet the requirement in MPEP §806.04(b) that where species of carbon compounds may be related to each other as intermediate and final product, these species are not <u>*independent*</u>, and that in order to sustain a restriction requirement under those circumstances, <u>*distinctness must be shown*</u>. *"Distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product. Otherwise, the disclosed relationship would preclude their being issued in separate patents"*. The showing which is necessary to establish distinctness in cases concerning intermediates and final products is also addressed in the last paragraph of MPEP §806.04(b) where it is stated *"the intermediate must be shown to be useful to make other than the final product. The examiner must give an example of an alternative use ..."*. The Examiner's argument that *"the intermediate is deemed useful as product"* cannot be considered to meet the burden on the Examiner for establishing distinctness between the compounds (I) and the intermediates (III), and the first of the two criteria for a proper restriction requirement set forth in MPEP §803 has not been met.

Furthermore, the intermediates (III) constitute an integral part of applicants' process of making the compounds (I), and -as such- any prior art relating to the intermediate is also pertinent with regard to the process in which the intermediate is applied and *vice versa*. The second of the criteria for a proper restriction requirement, therefore, cannot be considered to be met. Favorable reconsideration

of the Examiner's position and withdrawal of the respective restriction requirement is solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a *four* month extension of time be granted in this case. A check for the *$1,440.00* fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF

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